



FEB 26 2002

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In re Application of
SUGINO
Application No.: 09/831,622
PCT No.: PCT/JP99/06275
Int. Filing Date: 11 November 1999
Priority Date: 13 November 1998
Attorney Docket No.: 2001_0559A
For: NOVEL PROTEIN UTILIZATION
THEREOF

DECISION ON REQUEST

This decision is a reply to applicant's "Response" filed via facsimile in the Patent and Trademark Office (PTO) on 09 January 2002.

BACKGROUND

On 11 November 1999, applicant filed international application PCT/JP99/06275 which claimed a priority date of 13 November 1998. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States at midnight on 13 May 2001. The international application listed Hiroshi Sugino as applicant/inventor.

On 11 May 2001, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; a preliminary amendment; and declaration executed by Hiromu Sugino.

On 05 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b) must be filed. The notification indicated that the declaration was not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68. The notification set a two-month time limit in which to respond.

On 15 October 2001, applicant filed "Response" which stated that, "[a]n executed declaration was submitted with the filing of the 371 application on May 11, 2001." Applicant included a copy of the declaration filed 11 May 2001.

On 18 December 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the

declaration filed 11 May 2001 was not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68 and does not identify the inventor. The notification set a two-month time limit in which to respond.

On 09 January 2002, applicant filed "Response" which states, "[t]he PTO is respectfully requested to use the correct spelling of the inventor's name in the PTO records, as shown on the executed Declaration submitted herewith. The PTO is respectfully requested to disregard the spelling error in the first name of the first inventor which appears in the international application papers."

DISCUSSION

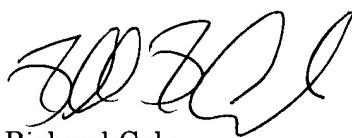
A review of the application file, including applicant's statements in the present response, reveal that the "correct spelling of the first name of the first inventor is 'Hiromu,' as indicated in the executed Declaration previously filed," not Hiroshi as indicated in the international application. In that this is clearly more than a mere typographical error or a phonetic misspelling of applicant's given name a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of \$130 as well as verified statements from the inventor and any other persons having firsthand knowledge of the error. These statements must set forth the specific circumstances as to how and when the error was made and discovered, and must also set forth that the mistake was an inadvertent error without deceptive intent.

CONCLUSION

For the reasons above, the request is **DISMISSED** without prejudice.

A proper response must include a declaration in compliance with 37 CFR 1.66 or 1.68 executed by all of the named inventors. Applicant is required to complete the response within the time remaining set forth in the Notification of Missing Requirements, mailed 05 October 2001. The period for response set in the Notification of Missing Requirement may be extended up to a maximum of five months, i.e., 05 May 2002.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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